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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/981,877
Filing Date: October 18, 2001
Appellant(s): MARTINEZ ET AL.

Frank C. Nicholas (reg. 33,983)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-14-2006.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Microsoft Corporation. "Microsoft Word 2000", Microsoft Corporation, 1999, attached screen shots: MS figure 1 trough MS figure 10

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Microsoft, "Microsoft Word," hereinafter MSword.

3. With regard to claim 1, which teaches a method of previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 1, further teaching displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a preview of a clipboard item in response to a mouse over event.

4. With regard to claims 2 and 10, which teach receiving an icon preview instruction comprises determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period, MSword teaches, in MS figures 2 and 3, the preview being delayed by some predetermined time.

5. With regard to claims 3 and 11, which teach displaying the graphical image comprises displaying a reduced image of the graphical image, MSword teaches, in MS figures 2 and 9, upon positioning an indicator over an element in the clipboard, displaying a subset of the text copied to the clipboard.

6. With regard to claim 4, which teaches a method of displaying a clipboard comprising: receiving a paste command, MSword teaches, in figure 2 and 4, receiving a paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad. With regard to claim 4, which further teaches determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first, and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen. With regard to claim 4, further teaching displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than on item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items.

7. With regard to claims 5 and 13, which teach displaying a clipboard adjacent the display position indicator comprises positioning an icon associated with a last pasted object adjacent the display position indicator, MSword teaches, in figures 1 and 2, displaying the clipboard adjacent to the pointer where the last pasted object is located at the end of the list.

8. With regard to claims 6 and 14, which teach hiding the clipboard in response to selecting an icon corresponding to an image on a clipboard, MSword teaches, in figures 6 and 7, hiding the clipboard items, upon selection of an item, from a docked clipboard, to be pasted.

9. With regard to claims 7 and 15, which teach hiding the clipboard in response to moving the position indicator so that the position indicator is not adjacent to the clipboard, MSword teaches, in figures 6 and 7,hiding the clipboard upon position the indicator off of the clipboard and onto the document.

10. With regard to claims 8 and 16, which teach hiding the clipboard in response to selecting a close icon on the clipboard, MSword teaches, in figure 2, an "X" icon in the clipboard window, that upon selection closes the clipboard window.

11. With regard to claim 9, which teaches a computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: computer readable code for receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 9, further teaching computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a preview of a clipboard item in response to a mouse over event.

12. With regard to claim 12, which teaches a computer usable medium including a program for displaying a clipboard (see MS figure 2), comprising: computer readable code for receiving a paste command, MSword teaches, in figure 2 and 4, receiving a

paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad. With regard to claim 12, which further teaches computer readable code for determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first, and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen. With regard to claim 12, further teaching computer readable code for displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than on item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items.

(10) Response to Argument

With respect to the group of claims including Claims 1-16, the Appellant's arguments are focused on the limitations regarding the "displaying a graphical image associated with the icon". More specifically, as stated from representative Claim 1, the limitation argued is:

displaying the graphical image associated with the icon in response to the icon preview instruction

Since the interpretation of the limitation is the basis for the arguments, the Examiner's interpretation is now given. The Examiner asserts the limitation 'displaying the graphical image associated with the icon' as being very broad and not explicit about

the representative "image." A graphical image comprises any image displayed on a screen, whether being textual, pictorial, etc., in nature. As stated in the eighth paragraph of MPEP 2101[R2].II.C.,

> "*Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure*. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997)."

Based on the interpretation of the claim limitations being argued, the Examiner will now explain how the teachings of the reference Microsoft Word, hereinafter MSword, are within the scope of these limitations.

MSword teaches a system that allows a user to copy and paste items inside the document window (as displayed in MS figure 1), these items, once copied are placed on a clipboard, and upon copying of multiple items the user is supplied with a Clipboard of available items copied and ready for further action (see MS figure 2). A user can then select items to be pasted via selecting an icon, representing the copied subject matter, on the Clipboard (see MS figures 2-4). Should the user desire to see what subject matter each icon represents, the user can move their pointer over an icon, the icon then provides a graphical depiction of what copied content the icon represents (see MS figures 2 and 5). The Examiner interprets the textural description of the icons contents to be a graphical image, as any element displayed on the display is a graphical depiction

of the stored subject matter. The examiner contends that when text is displayed on a display the text itself is a graphical image.

The examiner will now address the individual arguments and statements made by the Appellant.

From pages 9 and 10 of the Appeal Brief, from the second paragraph on page 9 to first paragraph continued on page 10, the Appellant argues "As the "reference" does not disclose 'displaying the graphical image associated with the icon in response to the icon preview instruction,' as claimed in claim 1," the applicant argues that at most the reference is a text sample of a clipboard icon, and not a graphical image.

The examiner contends that MSword does show a graphical image (a box surrounding the graphical image of text 'The cat ran up'), associative of an icon (the 'W' on a page), in response to an icon preview instruction (the user positioning the cursor over the icon) (see MS figure 2). The examiner further contends that the depiction is indeed a text sample, but is rendered as a graphical depiction on the display. The claims are silent to any processing that takes place prior to the graphical display of the image, and though it may be a textural description, when rendered it is a graphical image.

From pages 9 and 10 of the Appeal Brief, from the third paragraph on page 9 to first paragraph continued on page 10, the Appellant further argues that "Were the Examiner's computer using a graphical image, the fonts on the two samples, (i.e. on the screen and on the popup) would be identical."

The examiner contends that this argument by the applicant proves nothing and only shows that the text, stored in memory, has been access and displayed as graphical images using two different fonts.

From page 10 of the Appeal Brief, in the first full paragraph, the appellant argues that "MS figure 9 not only does not disclose the claimed elements, MS figure 9 equivocally teaches away from displaying a graphical image – "If the item is a drawing object or picture, or an item that doesn't contain text, Microsoft Word displays a label "Picture 2," which indicates the order in which the item was copied." Such a statement clearly indicates not only the reference does not teach displaying "the graphical image associated with the icon," but the statement directly teaches away from doing such an action."

The examiner contends that the teaching of MS figure 9, shows the graphical depiction "Picture 2", which is a graphical image (a box containing a graphical depiction of the text "Picture 2"), displayed to indicate the order in which the item was copied (therefor being representative of the contents). The examiner further contends that the depiction is indeed a textual description, but is rendered as a graphical image on the display.

From page 10 of the Appeal Brief, in the first paragraph, the appellant argues that "MS figure 9 teaches and discloses that the program can only preview "50 characters of text."

The examiner does not see where this teaching contrasts with the teaching of the appellant. The appellant provides not explanation of why this teaching of MSword contrasts to the Applicant's invention.

From page 10 of the Appeal Brief, in the third full paragraph, the appellant argues that "The Examiners argument that "MSword" discloses a graphical image associated with an image on the clipboard is disingenuous. Claim 1 requires displaying the graphical image associated with the icon in response to the icon preview instruction and not the "image on the clipboard.""

The examiner contents that all three, the represented item, the items representation on the clipboard, and the preview of the item upon moving the cursor over the representation of the item on the clipboard, are all related. The item being copied (as shown in MS figure 1), is then stored in the clipboard (as displayed in figures 2 and 3) and upon mouse over, provides a graphical image of associated with both the icon and the original image.

From page 10 of the Appeal Brief, in the fourth full paragraph, the appellant argues that, "Applicants further note that the "reference" does not teach or suggest the desirability of using a graphical icon as a preview.

The examiner contents that the reference clearly shows that providing a graphical image associated with an icon, informs the user of what the contents of the icon is (see MS figure 2). Through this means, the user can determine which item he or she wants to access among the plurality of items available on the Clipboard.

From page 11 of the Appeal Brief, in paragraphs 1 and 2, the appellant argues that, "MSWord is not prior art, per MPEP 2128." "First, the Examiner has not stated, nor even alleged, that the documents were ever publicly accessible, much less accessible to persons concerned with the art to which the documents relate. The Examiner admits that the documents are screen shots of the Examiner's own computer taken April 22, 2004. Thus the earliest these documents could possibly have been publicly accessible is 2.5 years after the filing of this application.

The examiner contend that to qualify as a reference under 35 U.S.C. 102 (a),

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The MSWord reference meets this limitation, as is shown by figure 8, stating that the Copyright for the Microsoft Word 2000 program is 1983-1999. This date

alone proves that the MSWord reference was known and used prior to the filing of the applicants claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 24, 2007

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